

## **REMARKS**

Applicants initially presented claims 1-31 for examination. The Examiner mailed a final Office Action on October 1, 2007. Applicants filed a Notice of Appeal with regard to this application on April 1, 2008. The Office Action was received and its contents carefully reviewed. In response to the previous Office Action, Applicants filed a Request for Continued Examination concurrently with this Amendment.

In the above amendments, Applicants amended independent claims 1, 6, 11, 16, 21, and 26 to recite additional elements as well as dependent claims 2, 4, 5, 8-10, 13-15, 18, 19, 22, 24, 27, 29, and 30. Support for these amendments can be found at least in paragraphs [0068, 0115-0121, 0208] and throughout the Specification and Figures. Applicants also canceled claims 3, 7, 12, 17, 23, and 28. As now recited, claims 1, 2, 4-6, 8-11, 13-16, 18-22, 24-27, 29-31 are pending and are believed to be in condition for allowance. With respect, Applicants submit that the present Amendment complies with the submission requirements of a Request for Continued Examination and request reconsideration of the present application in light of the above amendments and the following remarks.

### **A. Claim Rejections Under 35 U.S.C. § 102**

Claims 1-4, 6-9, 11-14, 16-19, 21-24, and 26-30 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Spies et al. U.S. Patent Number 5,689,565 (the Spies patent). In view of the amendments above and the comments below, Applicants respectfully request reconsideration and withdrawal of these rejections.

#### **1. The Spies Patent Fails to Disclose All Elements of Amended Claim 1**

Amended independent claim 1 recites a file authentication requesting device that stores a computer program for requesting third party authentication of files in digital systems. The device includes a confirmation request module that processes at least one file to generate attributes and generates a request for a confirmation receipt from an authenticator device authenticating attributes of the at least one file. The device also includes a transferring module that transfers the generated attributes of the

at least one file to be authenticated and an identification of at least one of the requesting device and a user of the requesting device to the authenticator device from the requesting device, the attributes comprising at least an electronic fingerprint of the at least one file. The device also includes a receiving module that receives the confirmation receipt comprising at least authenticated file attributes after an authentication by the authenticator device, the authentication comprising at least a unique digital characterization of the attributes. At least one file authentication is received from the authenticator device in response to the request, and the transferring module need not transfer the at least one file to the authenticator device to perform the authentication.

The Spies patent, on the other hand, appears to disclose a cryptography system and method for providing cryptographic services for protecting a user's keys and prevents undesired access and use of cryptographic functions without authorization from the user. See col. 3, lines 6-9 of the Spies patent. Additionally, the Spies patent illustrates a secure interchange of commercial documents and instruments over an insecure communication system. See col. 5, lines 7-11 of the Spies patent.

The Spies patent fails to disclose or suggest a confirmation request module that processes at least one file to generate attributes and generates a request for a confirmation receipt from an authenticator device authenticating attributes of the at least one file as recited in amended claim 1 of the present application. While on page 1 of the October 1, 2007, Office Action the Examiner points to reference numeral 40 of Figure 2 as disclosing this recited element of amended independent claim 1, reference numeral 40 is simply a communications path with which documents and instruments of the Spies patent are transferred. See col. 7; lines 10-12 of the Spies patent. Throughout the Spies patent, there is explicit disclosure that both documents and instruments are transferred, not solely file attributes as recited in amended claim 1 of the present application. For example, the Spies patent discloses, "The document(s) and instrument(s) are both encrypted and sent together over a communication path 40 to the computing unit 24(b) at the first recipient participant 22(b)." See col. 7, lines 10-12 of the Spies patent.

Additionally, the Spies patent discloses that the transaction takes place between the parties of the transaction without a third party authenticator. To wit, Spies discloses, “As shown in FIG. 2, the transaction process involves communication among the participants to the transaction without any interaction between the participants and the trusted credential authority.” See col. 6, lines 61-64 of the Spies patent (emphasis added). The Spies patent then goes on to extol the benefits of eliminating a third party authenticator and teaches away from the system and method of the present invention. Specifically, there is no disclosure in the Spies patent of a system that generates a request for a confirmation receipt from an authenticator device authenticating attributes of the at least one file as recited in independent claim 1 or the related elements of the other independent claims.

Similarly, the Spies patent fails to disclose or suggest a transferring module that transfers the generated attributes of the at least one file to be authenticated and an identification of at least one of the requesting device and a user of the requesting device to the authenticator device from the requesting device where the generated attributes include at least an electronic fingerprint of the at least one file. While on pages 2 and 3 of the October 1, 2007, Office Action the Examiner points to reference numerals 42 and 46 of Figure 2 as disclosing this recited element of amended independent claim 1, reference numerals 42 and 46 are merely communications paths with which documents and instruments of the Spies patent are transferred. See col. 7; lines 10-12, lines 21-25, and lines 46-50. Throughout the Spies patent, the disclosure explicitly states that documents and instruments are transferred, not solely file attributes as in the disclosed subject matter of the present application.

For example, the Spies patent discloses, “The first recipient computing unit 24(b) then passes the other(s) of the commerce document(s) 36 or the commerce instrument(s) 38 in encrypted form over a communication path 42 to a second computing unit 24(c) at the second recipient participant 22(c).” See col. 7, lines 20-24 of the Spies patent. Additionally, the Spies patent discloses, “Assuming the second participant 22(c) can satisfy the commerce instrument, the computing unit 24(c) returns a signed authorization receipt 44 over communication path 46 to the first

recipient 22(b) indicating that payment is guaranteed.” See col. 7, lines 46-50 of the Spies patent.

Additionally, regarding reference numerals 42 and 46, the Spies patent discloses, “A computing unit 24(a) at the originating participant 22(a) is programmed to request and receive the credentials of all intended recipient computing units 24(b) and 24(c). The originating computing unit also verifies the credentials by checking the digital signature of the trusted credential authority.” See col. 7, lines 1-17 of the Spies patent (emphasis added). The credentials disclosed by the Spies patent are not file attributes. The Spies patent provides credentials to the parties to the transaction so that the system of the Spies patent can transfer documents and instruments between the parties. The Spies patent does not process a file to generate file attributes as recited in amended independent claim 1.

As can be seen from these examples, the system and method of the Spies patent is not a system that includes a transferring module that transfers the generated attributes of the at least one file to be authenticated and an identification of at least one of the requesting device and a user of the requesting device to the authenticator device from the requesting device where the generated attributes include at least an electronic fingerprint of the at least one file as recited in independent claim 1.

Additionally, there is no disclosure in the Spies patent of a receiving module that receives the confirmation receipt including at least authenticated file attributes after an authentication by the authenticator device, where the authentication includes a unique digital characterization of the attributes and where a file authentication is received from the authenticator device in response to the request and whereby the transferring module need not transfer the at least one file to the authenticator device to perform the authentication.

Instead, the Spies patent appears to discuss an electronic commerce system that passes an electronic commerce document to one computing system and an electronic commerce instrument to a second computing system. That is:

The first recipient computing unit 24(b) is programmed to decrypt either the commerce document(s) 36 or the commerce instrument(s) 38 depending upon which one(s) is intended for

and pertains to them. The first recipient computing unit 24(b) then passes the other(s) of the commerce document(s) 36 or the commerce instrument(s) 38 in encrypted form over a communication path 42 to a second computing unit 24(c) at the second recipient participant 22(c). The second recipient computing unit is programmed to decrypt the document(s) or instrument(s) intended for and pertaining to them.

See col. 7, lines 18-28 of the Spies patent (emphasis added).

The Spies patent fails to disclose or suggest all the elements recited in amended independent claim 1 of the present application. In fact, the Spies patent discloses that the “trusted credential authority” does not interact with the computing units as the transaction occurs. For example, “The first recipient computing unit 24(b) then sends a signed purchase receipt 48 over a communication path 49 to the originating computing unit 24(a).” See col. 7, lines 50-53 of the Spies patent. As discussed above, at col. 6, lines 61-64, the Spies patent discloses, “As shown in FIG. 2, the transaction process involves communication among the participants to the transaction without any interaction between the participants and the trusted credential authority.” (emphasis added). The Spies patent then touts this process disclosing, “This is beneficial because it eliminates the need to check with a trusted credential authority during each commercial transaction and streamlines communication during the transaction.” See col. 6, lines 64-67 of the Spies patent.

As such, the cited portion of the Spies patent does not disclose or suggest the confirmation request module, the transferring module, and the receiving module recited in amended independent claim 1. Therefore, Applicants respectfully request reconsideration of amended independent claim 1 and withdrawal of the rejection under 35 U.S.C. § 102(e).

## 2. The Spies Patent Fails to Disclose All Elements of Dependent Claims 2 and 4

Dependent claims 2 and 4 are dependent upon amended independent claim 1, and thereby include all the elements of independent claim 1, while reciting additional features of the disclosed subject matter. As noted above, amended independent claim 1 includes elements not disclosed or suggested by the Spies patent. Accordingly, for

at least the reason of the dependency of claims 2 and 4 on amended independent claim 1, Applicants respectfully submit that these claims are likewise in proper condition for allowance and respectfully request reconsideration of these claims and withdrawal of the rejection under 35 U.S.C. § 102(e).

3. The Spies Patent Fails to Disclose All Elements of Amended Independent Claims 6, 11, 16, 21, and 26

Applicants amended claim 6 above to recite additional features of the disclosed subject matter. Amended independent claim 6 now recites a file authenticator device that stores a computer program for processing requests for third party authentication of files in digital systems. The file authenticator device recited in claim 6 comprises a receiving module that receives attributes of at least one file to be authenticated and an identification of at least one of a requesting device and a user of the requesting device from the requesting device. The attributes are generated by the requesting device processing the at least one file and the attributes comprising at least an electronic fingerprint of the at least one file. Amended independent claim 6 also recites a processing module that processes a confirmation receipt, the processing comprising a unique digital characterization of the file attributes generated, assuring at least in part tampering and modification detection. Claim 6 further recites a sending module that creates a pending event for return of the confirmation receipt to the requesting device and sends the confirmation receipt comprising authenticated file attributes to the requesting device after processing. At least one file is authenticated by the authenticator device, and the receiving module need not receive the file to perform the authentication.

As indicated above with regard to amended independent claim 1, the Spies patent fails to disclose or suggest a receiving module that receives attributes of at least one file to be authenticated and an identification of at least one of a requesting device and a user of the requesting device from the requesting device, where the attributes generated by the requesting device processing the at least one file and the attributes comprising at least an electronic fingerprint of the at least one file as recited in

amended claim 6 of the present application. On page 4 of the October 1, 2007, Office Action, the Examiner applies the same grounds for rejecting claim 6 that was made with regard to claim 1. The Examiner points to reference numeral 40 of Figure 2 as disclosing this recited element of amended independent claim 6, but reference numeral 40 is simply a communications path with which documents and instruments of the Spies patent are transferred. See col. 7; lines 10-12 of the Spies patent. It is explicit throughout the Spies patent that documents and instruments are transferred, not solely file attributes as in the disclosed subject matter of the present application. There is no disclosure in the Spies patent of a receiving module with the elements recited in amended independent claim 6.

Similarly, the Spies patent fails to disclose or suggest a processing module as recited in claim 6 that processes a confirmation receipt. The processing includes a unique digital characterization of the file attributes generated, not the file, assuring at least in part tampering and modification detection. While on page 4 of the October 1, 2007, Office Action, the Examiner again points to reference numerals 42 and 46 of Figure 2 as disclosing this recited element of amended independent claim 6, reference numerals 42 and 46 are merely communications paths with which documents and instruments of the Spies patent are transferred. See col. 7; lines 10-12, lines 21-25, and lines 46-50. It is clear throughout the Spies patent that documents and instruments are transferred, not solely file attributes as in the disclosed subject matter of the present application. There is no disclosure in the Spies patent of a processing module with the elements recited in amended independent claim 6. Specifically, there is no disclosure in the Spies patent of a processing module that processes a confirmation receipt, where the processing includes a unique digital characterization of the file attributes generated, assuring at least in part tampering and modification detection.

There is no disclosure or suggestion in the Spies patent of a sending module that creates a pending event for return of the confirmation receipt to the requesting device and sends the confirmation receipt including authenticated file attributes to the requesting device after processing. There is no disclosure or suggestion in the Spies

patent that at least one file is authenticated by the authenticator device and that the receiving module need not receive the at least one file to perform the authentication. Instead, the Spies patent appears to discuss an electronic commerce system that passes an electronic commerce document to one computing system and an electronic commerce instrument to a second computing system. That is, “The first recipient computing unit 24(b) is programmed to decrypt either the commerce document(s) 36 or the commerce instrument(s) 38 depending upon which one(s) is intended for and pertains to them. The first recipient computing unit 24(b) then passes the other(s) of the commerce document(s) 36 or the commerce instrument(s) 38 in encrypted form over a communication path 42 to a second computing unit 24(c) at the second recipient participant 22(c). The second recipient computing unit is programmed to decrypt the document(s) or instrument(s) intended for and pertaining to them.” See col. 7, lines 18-28 of the Spies patent (emphasis added).

The Spies patent fails to disclose or suggest all the elements recited in amended independent claim 6. As such, Applicants respectfully request reconsideration of amended independent claim 6 and withdrawal of the rejection under 35 U.S.C. § 102(e) for at least these reasons.

Similarly, Applicants also amended independent claim 11 to recite additional elements regarding the file authentication requesting device, confirmation request processing device, and transferring device as similarly recited above with regard to amended independent claim 1 and claim 6.

Likewise, Applicants also amended independent claim 16 to recite additional elements regarding the receiving source code segment, the processing source code segment, and the sending source code segment as similarly recited above with regard to amended independent claims 1, 6, and 11.

Additionally, Applicants also amended independent claim 21 to recite additional elements regarding the confirmation request source code segment, the transferring source code segment, and the receiving source code segment as similarly recited above with regard to amended independent claims 1, 6, 11, and 16.



Further, Applicants also amended independent claim 26 to recite additional elements regarding requesting a confirmation receipt, transferring attributes, processing the confirmation receipt, creating a pending event for return of the confirmation receipt, sending the confirmation receipt, and receiving the confirmation receipt as similarly recited above with regard to amended independent claims 1, 6, 11, 16, and 21.

The Examiner used the identical grounds of rejection for these independent claims 11, 16, 21, and 26 that were used to reject independent claims 1 and 6. Applicants respectfully submit that the Spies patent fails to disclose or suggest all the elements outlined above with regard to claims 1 and 6 and further that the Spies patent also fails to disclose or suggest all the elements of claims 11, 16, 21, and 26 recited in the attached listing of claims for at least the reasons as outlined above with regard to claim 1 and claim 6.

4. The Spies Patent Fails to Disclose All Elements of Dependent Claims 8 and 9, Dependent Claims 13 and 14, Dependent Claims 18 and 19, Dependent Claims 22 and 24, and Dependent Claims 27, 29, and 30.

Dependent claims 8 and 9 are dependent upon amended independent claim 6, and thereby include all the elements of independent claim 6, while reciting additional features of the disclosed subject matter. As noted above, amended independent claim 6 includes elements not disclosed or suggested by the Spies patent. Accordingly, with the dependency of claims 8 and 9 on amended independent claim 6, Applicants respectfully submit that these claims are likewise in proper condition for allowance and respectfully request the reconsideration of these claims and the withdrawal of the rejection under 35 U.S.C. § 102(e) for at least these reasons.

Dependent claims 13 and 14 are dependent upon amended independent claim 11, and thereby include all the elements of independent claim 11, while reciting additional features of the disclosed subject matter. As noted above, amended independent claim 11 includes elements not disclosed or suggested by the Spies patent. Accordingly, with the dependency of claims 13 and 14 on amended

independent claim 11, Applicants respectfully submit that these claims are likewise in proper condition for allowance and respectfully request reconsideration of these claims and withdrawal of the rejection under 35 U.S.C. § 102(e) for at least these reasons.

Dependent claims 18 and 19 are dependent upon amended independent claim 16, and thereby include all the elements of independent claim 16, while reciting additional features of the disclosed subject matter. As noted above, amended independent claim 16 includes elements not disclosed or suggested by the Spies patent. Accordingly, with the dependency of claims 18 and 19 on amended independent claim 16, Applicants respectfully submit that these claims are likewise in proper condition for allowance and respectfully request reconsideration of these claims and withdrawal of the rejection under 35 U.S.C. § 102(e) for at least these reasons.

Similarly, dependent claims 22 and 24 are dependent upon amended independent claim 21, and thereby include all the elements of independent claim 21, while reciting additional features of the disclosed subject matter. As noted above, amended independent claim 21 includes elements not disclosed or suggested by the Spies patent. Accordingly, with the dependency of claims 22 and 24 on amended independent claim 21, Applicants respectfully submit that these claims are likewise in proper condition for allowance and respectfully request reconsideration of these claims and withdrawal of the rejection under 35 U.S.C. § 102(e) for at least these reasons.

Dependent claims 27, 29, and 30 are dependent upon amended independent claim 26, and thereby include all the elements of independent claim 26, while reciting additional features of the disclosed subject matter. As noted above, amended independent claim 26 includes elements not disclosed or suggested by the Spies patent. Accordingly, with the dependency of claims 27, 29, and 30 on amended independent claim 26, Applicants respectfully submit that these claims are likewise in proper condition for allowance and respectfully request reconsideration of these

claims and withdrawal of the rejection under 35 U.S.C. § 102(e) for at least these reasons.

**B. Claim Rejections Under 35 U.S.C. § 103**

Claims 5, 10, 15, 20, and 31 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over Spies et al. U.S. Patent Number 5,689,565 in view of Cordery et al. U.S. Patent Number 5,796,841. In view of the amendments above and the comments below, Applicants respectfully request reconsideration and withdrawal of these rejections.

As indicated in the above listing of claims, Applicants amended independent claims 1, 6, 11, 16, 21, and 26 to highlight additional features of the disclosed subject matter and to add additional context to the claims.

1. 103(a) Rejection of Dependent Claim 5 with Regard to Spies and Cordery

Dependent claim 5 depends upon previously amended independent claim 1. Therefore, this dependent claim includes all the elements of independent claim 1, while reciting additional features of the disclosed subject matter. As noted previously, Applicants amended independent claim 1 to include elements neither disclosed nor suggested by the Spies patent. Further, the Cordery patent fails to remedy the shortcomings of the Spies patent as discussed above in that the Cordery patent fails to disclose or suggest a confirmation request module that processes at least one file to generate attributes and generates a request for a confirmation receipt from an authenticator device authenticating the attributes of the at least one file. Instead, the Cordery patent appears to be directed to a system and method for processing a cryptographic certificate and to provide security services as well as payment for such processing and services using postage evidencing devices.

Similarly, the Cordery patent fails to disclose or suggest a transferring module as recited in claim 1 that transfers the generated attributes of the at least one file to be authenticated and an identification of at least one of the requesting device and a user of the requesting device to the authenticator device from the requesting device, the

attributes comprising at least an electronic fingerprint of the at least one file. Further, the Cordery patent fails to teach or suggest a receiving module that receives the confirmation receipt comprising at least authenticated file attributes after an authentication by the authenticator device, where the authentication comprises at least a unique digital characterization of the attributes as also recited in amended independent claim 1.

There is no disclosure or suggestion in the Cordery patent of a file authentication requesting device with the elements recited in amended independent claim 1. Instead, the Cordery patent appears to disclose a payment system implementing certification processes using key management. See col. 2, lines 15-24 of the Cordery patent. While the Cordery patent appears to employ a means for processing a cryptographic certificate adapted to provide security functionality, the Cordery patent processes a digital token as proof of payment, but focuses on secure validation of payment rather than on the file attributes as recited in the elements of the amended independent claims of the present application. See col. 3, lines 42-61 of the Cordery patent. The Cordery patent fails to remedy the shortcomings of the Spies patent discussed above with regard to amended independent claim 1 of the present application.

Accordingly, with the dependency of claim 5 on amended independent claim 1, Applicants respectfully submit that the combination of the Spies patent and the Cordery patent fails to disclose or suggest all the recited elements of claim 5. As such, neither the Spies patent, nor the Cordery patent, either alone or in combination, produce a file authentication requesting device for requesting third party authentication of files in digital systems that includes a confirmation module that processes at least one file to generate attributes and generates a request for a confirmation receipt from an authentication device authenticating attributes of the at least one file, and includes a transferring module that transfers the generated attributes of the at least one file to be authenticated and an identification of at least one of the requesting device and a user of the requesting device to the authenticator device from the requesting device, where the attributes include at least an electronic fingerprint of

the at least one file. In fact, the Cordery patent discloses that a postal authority is a “natural choice for a certificate authority.” See the Cordery patent at col. 3 lines 42-50 (emphasis added). A certificate authority is not a third party authenticator that authenticates file attributes received in a confirmation receipt request. In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the rejection of dependent claim 5 under 35 U.S.C. § 103 for at least these reasons.

2. 103(a) Rejection of Dependent Claims 10, 15, 20, 25, and 31 with Regard to Spies and Cordery

As indicated above, Applicants amended independent claims 6, 11, 16, 21, and 26 to include similar elements as outlined above with regard to amended independent claim 1. Dependent claim 10 depends upon amended independent claim 6. Likewise, dependent claim 15 depends upon amended independent claim 11. Dependent claim 20 depends upon amended independent claim 16, while dependent claim 25 depends upon amended independent claim 21, and dependent claim 31 depends upon amended independent claim 26.

As noted previously, Applicants amended these independent claims to include elements similar to those recited in amended independent claim 1. As such, Applicants respectfully assert that the elements recited in amended independent claims 6, 11, 16, 21, and 26 are neither disclosed nor suggested by the Spies patent for at least the reasons outlined above with regard to claim 1. Further, the Cordery patent fails to remedy the shortcomings of the Spies patent as discussed above with regard to claim 1. Accordingly, Applicants respectfully request the reconsideration of claims 10, 15, 20, 25, and 31 and withdrawal of the rejection under 35 U.S.C. § 103 for at least the reasons discussed above with regard to claim 1.

**C. Conclusion**

Applicants respectfully request that the Examiner reconsider and withdraw the rejections of record, allow claims 1, 2, 4-6, 8-11, 13-16, 18-22, 24-27, 29-31, and pass the present application to issue. If the Examiner believes that a conference would be

beneficial in expediting the prosecution of the present application, Applicants invite the Examiner to telephone counsel to arrange such a conference.

Except for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application, including fees due under 37 C.F.R. §§ 1.16 and 1.17, which may be required, including any required extension of time fees, or to credit any overpayment to Deposit Account No. 19-2380. This paragraph is intended to be a CONSTRUCTIVE PETITION FOR EXTENSION OF TIME in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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